

REMARKS

Applicants propose amending claims 1, 9, 17, 21, 24, and 27 for further clarity and without changing the scope thereof. Claims 1-32 remain pending in this application.

In the Final Office Action,¹ the Examiner rejected claims 1-30 under 35 U.S.C. § 112, second paragraph, as being indefinite. While Applicants respectfully traverse the rejection, in order to expedite prosecution, Applicants propose amending independent claims 1, 9, 17, 21, 24, and 27 as suggested by the Examiner. Claims 2-8, 10-16, 18-20, 22-24, 25, 26, and 28-30 depend from one of independent claims 1, 9, 17, 21, 24, and 27. Applicants submit that the amendments to the claims do not raise new issues requiring further search or consideration, and accordingly, respectfully request that the Examiner enter the amendments and withdraw the rejection of claims 1-30 under 35 U.S.C. § 112, second paragraph.

The Examiner also rejected claims 1, 2, 4-6, 9, 10, 12, 13, 21, 24, and 31 under 35 U.S.C. § 102(e) as being anticipated by Bull et al. (U.S. Patent No. 5,995,943); rejected claims 3, 7, 11, 14, 15, 22, and 25 under 35 U.S.C. § 103(a) as being obvious over Bull; rejected claims 8, 16, 23, and 26 under 35 U.S.C. § 103(a) as being obvious over Bull in view of Kirsch et al. (U.S. Patent No. 6,189,030); rejected claims 17-19, 27-29, and 31 under 35 U.S.C. § 103(a) as being obvious over Bull in view of Murray

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

(U.S. Patent No. 6,061,659); and rejected claims 19, 20, 29, 30, and 32 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray and further in view of Kirsch.

I. REJECTION UNDER 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 1, 2, 4-6, 9, 10, 12, 13, 21, 24, and 31 under 35 U.S.C. § 102(e) as anticipated by Bull. In order to properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131.

Claim 1, as proposed to be amended, recites an apparatus for hyperlinking specific words in content to turn the words into advertisements including, among other things, "an ad server connected to the Internet, wherein the ad server provides means for providing a hypertext anchor to *convert at least one existing advertiser-chosen word present in a content file into an advertisement* by linking said at least one advertiser-chosen word to said advertiser web page" (emphasis added). Bull does not teach at least this element of claim 1.

In the Final Office Action, the Examiner contends the "chosen word(s) present in a context file, *Holiday Inns on the West Coast*, are taught at col. 15, lines 39-42" (emphasis in original). See page 4. Applicants disagree for the following reasons.

Specifically, col. 15, lines 39-42 of Bull states:

As an example, if the user accesses web pages for “Holiday Inns on the West Coast”, the insertion mechanism would be established to automatically insert ads for “Hilton Inns on the West Coast.”

Bull, therefore, teaches that ads for “Hilton Inns on the West Coast” are inserted into a web page after it is determined that a user has accessed a web page for “Holiday Inns on the West Coast.” However, this teaching of Bull does not constitute a conversion of an existing word in a content file into an advertisement. Rather, according to Bull, an “ad is inserted based on the content of the existing web page being read” (emphasis added). See col. 5, lines 19-20. More particularly, according to Bull, the ad is inserted as a new piece of information. This teaching is demonstrated by Fig. 6, which shows an arrow labeled “GET AD TO INSERT,” indicating that the ad is retrieved from advertising database 250. In other words, Bull discloses that its system will “cause an advertisement/coupon to be added into the display” (emphasis added). See col. 12, lines 15-16. While Bull teaches that an ad is added to the display, that ad does not constitute converting an existing word in the content file into an advertisement. Since Bull fails to teach converting an existing word, Bull does not teach at least the claimed “means for providing a hypertext anchor to convert at least one existing advertiser-chosen word present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page,” as recited in claim 1 (emphasis added).

Since the Examiner has not pointed to any teaching in Bull that discloses “means for providing a hypertext anchor to convert at least one existing advertiser-chosen word present in a content file into an advertisement by linking said at least one

advertiser-chosen word to said advertiser web page,” as recited in claim 1, the rejection of claim 1 under 35 U.S.C. § 102(e) is improper for at least this reason. Therefore, the Examiner should withdraw the rejection of claim 1, and claims 2 and 4-6, which depend from claim 1, and allow the claims.

The Examiner rejected independent claims 9, 21, and 24 under the same reasoning. These claims, while of a different scope, include recitations similar to allowable claim 1. Accordingly, the Examiner should withdraw the rejection of claims 9, 21, and 24. Dependent claims 10 and 12-13, which depend from allowable independent claim 9, are also allowable.

Furthermore, independent claim 31 recites a method including, among other steps, “displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink.” Bull does not teach at least this element of claim 31.

The Examiner admits “Bull et al. does not explicitly teach (independent claim 31) displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink” (emphasis in original). See Final Office Action, page 4. The Examiner then alleges that principles of inherency make up for this admitted deficiency of Bull. Applicants disagree.

MPEP § 2112.02 explains that, “[u]nder the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process.” See MPEP § 2112.02, citing *In re King*, 801 F.2d 1324,

231 USPQ 136 (Fed. Cir. 1986). The Examiner cites a portion of Bull that “teaches clicking on a URL ... to access a Web page.” See Office Action, page 4. As a result of this teaching, the Examiner alleges that “[t]he mouse pointer must inherently be positioned over the URL link in order to activate said link by clicking on it.”

However, positioning a mouse pointer over a URL link in order to click on the link does not constitute “displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink,” as recited in claim 31 (emphasis added). Applicants further disagree that the principles of inherency apply, because nothing in Bull indicates that it would “necessarily perform the method claimed,” as required by MPEP § 2112.02. Instead, Bull only discloses clicking a URL, but not “displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink,” as recited in claim 31 (emphasis added). Accordingly, the Examiner has not shown that Bull anticipates all of the elements of claim 31. Therefore, the Examiner should withdraw the rejection and allow claim 31.

II. REJECTIONS UNDER 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 3, 7, 11, 14, 15, 22, and 25 under 35 U.S.C. § 103(a) as obvious over Bull. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary

skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claims 3 and 7 depend from claim 1; claims 11, 14, and 15 depend from claim 9; claim 22 depends from claim 21; and claim 25 depends from claim 24. As discussed above, Bull does not teach every element of independent claims 1, 9, 21, and 24. Accordingly, Bull does not disclose or suggest all elements of claims 3, 7, 11, 14, 15, 22, and 25, at least due to their dependence from allowable claims. Therefore, the Examiner should withdraw the rejection at least for the reasons given above.

In addition, Applicants again traverse the Examiner's taking of Official Notice and respectfully disagree with the Examiner's contention that the prior traversals found in the Request for Reconsideration filed November 1, 2004, the Amendment filed January 27, 2005, and the Amendment filed July 11, 2005, were insufficient. Applicants again respectfully request that the Examiner provide the explicit basis on which the Examiner regards the matter as subject to Official Notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made, or else withdraw the rejection.

Applicants respectfully traverse the rejection of claims 8, 16, 23, and 26 under 35 U.S.C. § 103(a) as being obvious over Bull in view of Kirsch. Claim 8 depends from claim 1, claim 16 depends from claim 9, claim 23 depend from claim 21, and claim 26 depends from claim 24. As discussed above, Bull fails to teach or suggest every

element of claims 1, 9, 21, and 24 and their dependent claims. Furthermore, Kirsch does not compensate for the shortcomings of Bull.

The Examiner applies Kirsch, alleging that Kirsch discloses “linking to said advertiser web page ... using a tracking server system.” See Final Office Action, page 5. Even if this allegation were true, which Applicants do not concede, Kirsch does not disclose or suggest at least “providing a hypertext anchor to convert at least one existing advertiser-chosen word present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page,” as recited in claim 1, for example. For at least these reasons, the references fail to teach or suggest all of the elements of claims 8, 16, 23, and 26. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the section 103 rejections of these claims.

Applicants respectfully traverse the rejection of claims 17-19, 27-29, and 31 under 35 U.S.C. § 103(a) as being obvious over Bull in view of Murray. Independent claim 17 recites “altering the HTML coding of content for an Internet-displayed file to include a hypertext anchor to convert at least one existing advertiser-chosen word present in the content into an advertisement by linking said at least one advertiser-chosen word to an advertiser web page.” Independent claim 27 recites “altering the document file with software to include a hypertext anchor to convert at least one existing advertiser-chosen word present in the document file into an advertisement by linking said at least one advertiser-chosen word to an advertiser document.” Finally, independent claim 31 recites “displaying a description of the advertiser web page when

a mouse pointer is positioned over the hyperlink.” As discussed above, Bull does not disclose or suggest at least these elements.

Furthermore, Murray does not make up for the deficiencies of Bull. Murray instead discloses a system that uses HTML documents to provide content through a browser using pre-defined HTML tags. See col. 5, lines 14-16; col. 6, lines 32-39. Since Murray does not disclose or suggest “altering the HTML coding of content for an Internet-displayed file to include a hypertext anchor to convert at least one existing advertiser-chosen word present in the content into an advertisement by linking said at least one advertiser-chosen word to an advertiser web page,” as recited in claim 17 or “altering the document file with software to include a hypertext anchor to convert at least one existing advertiser-chosen word present in the document file into an advertisement by linking said at least one advertiser-chosen word to an advertiser document,” as recited claim 27, a *prima facie* case of obviousness has not been established with respect to independent claims 17 and 27. Furthermore, dependent claims 18-19 and 28-29 depend from allowable independent claims 17 and 27 and are allowable at least due to their dependence.

Applicants respectfully traverse the rejection of claims 19, 20, 29, 30, and 32 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray and further in view of Kirsch. Claims 19 and 20 depend from independent claim 17. Claims 29 and 30 depend from independent claim 27. Claim 32 depends from independent claim 31. As discussed above, Bull in view of Murray does not disclose or suggest all elements of claims 17, 27, and 31. Nor does Kirsch make up for the deficiencies of Bull and Murray. Accordingly, claims 19, 20, 29, 30, and 32 are allowable at least due to their

dependence. Therefore, the Examiner should also withdraw the rejection of claims 19, 20, 29, 30, and 32 under 35 U.S.C. § 103(a).

CONCLUSION

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing claims 1-32 in condition for allowance. Applicants submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

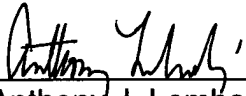
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 5, 2006

By: 
Anthony J. Lombardi
Reg. No. 53,232